

REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and following remarks is respectfully requested.

A. Status of the Claims And Explanation Of Amendments

Claims 1-24 are pending. As the outset, Applicant wishes to thank the Examiner for the indication of allowable subject matter in claim 7.

As to matters of form, the office action requested that the title be amended to be more descriptive. By this paper, the title has been amended. Applicant notes, however, that the title is being changed, as provided in MPEP § 606.01 to gain “informative value in indexing, classifying, searching, etc.”

Claims 2, 5-7 and 10-11 also were rejected as to matters of form. Claim 2 was rejected pursuant to 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to claim the subject matter. [12/16/04 office action at ¶3]. The office action finds it unclear what is being referred by the phrase “[t]he apparatus according to claim 1.” Claim 1 refers to “[a]n image processing apparatus” and the “other apparatus.” By this paper, the preambles of claims 2-18 to recite “The image processing apparatus...” instead of “The apparatus” to alleviate this concern. Similar amendments to the preambles of the other pending claims also have been made. These amendments are not made for any substantial reason related to patentability (i.e., § 102 or 103).

Claims 5-7, 10-11 were rejected pursuant to 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. [12/16/04 office action at ¶2]. Specifically, the office action suggests it is confusing that claim 1 recites that the power controller controls the switch, and claim 5 recites that a main controller also controls the same

switch. The office action alleges that the specification fails to disclose how two controllers can control a single switch.

Reconsideration of this rejection is requested in light of the discussion below. As a legal principle, applicant notes that a broad claim can be enabled by disclosure of a single embodiment. *In re Cook*, 439 F.2d 730, 735, 169 USPQ 298 , 301 (CCPA 1971); *see also* MPEP § 2164.03 (“A single embodiment may provide broad enablement in cases involving predictable factors, such as mechanical or electrical elements.”) Here, that standard is clearly met.

As described in one embodiment disclosed in Applicant’s specification, switch (104) is controlled by signal SPOWER_ON2. If that signal is hi, the switch is closed and AC input power is connected to the DC power supply. [Specification at ¶0059]. If that signal is lo, the switch is open and no power is supplied. [Specification at ¶0059]. Whether SPOWER_ON2 is hi or low is, in turn, determined by a 2-input OR gate (114). This OR gate (114) receives signal SPOWER2 and signal POWER_LIVE. [Specification at ¶0071]. SPOWER2 is generated by the power control circuit (120). [Specification at ¶¶0064-65]. POWER_LIVE is generated by the CPU (103). [Specification at ¶0065]. If SPOWER2 or POWER_LIVE are hi, the signal SPOWER_ON2 also is hi. [*See, e.g.*, Figure 2]. Thus, the switch (104) connects the AC input power to the DC power supply whenever the power control circuit (120), the CPU (103) or both, determine that should be done. Thus, Applicant respectfully asserts that the specification does,

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in fact, disclose an embodiment for having two controllers for a single switch, and would enable one of ordinary skill in the art to practice the invention.¹ Withdrawal is respectfully requested.

As to the merits, claims 1-3, 18-19, 22-24 were rejected pursuant to 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,526,516 to Ishikawa et al. (“Ishikawa”) in view of U.S. Patent No. 5,812,386 to Youn (“Youn”). [12/16/04 office action at ¶4]. Claims 4-11, 20-21 were rejected pursuant to 35 U.S.C. § 103(a) as allegedly being unpatentable over Ishikawa in view of Youn and further in view of U.S. Patent Publication No. US 2002/0126516 to Jeon (“Jeon”). [12/16/04 office action at ¶5]. Claims 12-17 were rejected pursuant to 35 U.S.C. § 103(a) as allegedly being unpatentable over Ishikawa in view of Youn and further in view of U.S. Patent No. U.S. 6,334,719 to Kimura (“Kimura”). [12/16/04 office action at ¶6].

By this paper, claims 3-10, 12-17, 20-21 and 23 have been amended. These claims are apparatus claims. These claims have been amended to clarify various structural elements are being claims, rather than modes of operation. For example, claim 3 has recites that “said power controller controls said switch...” It has been amended to recite that “said power controller is configured to control said switch.” These amendments are not made for any substantial reason related to patentability (i.e., § 102 or 103).

No new matter will be added to this application by entry of the foregoing amendments.

¹ The above discussion of an embodiment disclosed in the specification relates solely to the issue of enablement, and is not meant to limit the proper construction of the claims. It is, of course, the claims themselves that define the scope of the invention and not specific embodiments that are disclosed in the patent specification.

B. Claims 1-24 Are Patentably Distinct From Ishikawa Alone or
In Combination With the Various Secondary References

As explained below, the above rejections are traversed because all of the claim elements are not shown in the cited references. *See* MPEP §§ 2131 (“To Anticipate A Claim, The Reference Must Teach Every Element Of The Claim”) and 2141.03 (“all the claim limitations must be taught or suggested by the prior art”). Specifically, none of the cited documents teaches, discloses or suggests a power controller adapted to control said switch by using electric power supplied from the other apparatus as in Applicant’s claim 1.

Ishikawa is directed to a power control system and method for distribution of power to peripheral devices. The office action relies primarily on Ishikawa’s figure 1, which depicts a block diagram illustrating the configuration of a power control system in a first embodiment. “The system includes a digital camera 109 serving as the image sensing device, a printer 117 serving as the image output device, and an AC adapter 123 serving as an external power source device.” [Col. 5, lns. 4-8]. There is no switch between the power input and the AC adapter 123. Accordingly, the office action correctly concedes that Ishikawa fails to teach, disclose or suggest a “switch” and, therefore, also fails to disclose a power controller adapted to control said switch by using electric power supplied from the other apparatus as in Applicant’s claim 1. [12/16/04 office action at ¶4 (p. 4)].

For this alleged disclosure, the office action relies on Yuon, which is directed to a power supply control method. A power switching circuit (204) is adapted to connect or disconnect AC POWER from an AC-DC converter DC power generator (206). [Col. 2, lns. 1-18]. A signal POWER CTL from controller (208) is used to open or close the power switching circuit (204). [Col. 2, lns. 19-39]. Importantly, the controller (208) is part of Yuon’s power supply control circuit and is not part of a separate apparatus. [Figure 2; Col. 1, lns. 62-67]. In

sum, Applicant cannot find a power controller adapted to control said switch by using electric power supplied from the other apparatus of Applicant's claim 1 in Yuon.

The remaining references, Jeon and Kimura, were cited by the office action for their alleged disclosure of various features recited in the dependent claims. The office action does not allege that these references disclose a power controller adapted to control said switch by using electric power supplied from the other apparatus as in Applicant's claim 1.

Accordingly, as Applicant cannot find a power controller adapted to control said switch by using electric power supplied from the other apparatus of Applicant's claim 1 in the cited documents, at least independent claims 1, 19, 23, and their dependent claims 2-18, 20-22 and 24 are respectfully asserted to be in condition for allowance.

Applicant has chosen in the interest of expediting prosecution of this patent applicant to distinguish the cited documents from the pending claims as set forth above. These statements should not be regarded in any way as admissions that the cited documents are, in fact, prior art.

Finally, Applicant has not specifically addressed the rejections of the dependent claims. Applicant respectfully submits that the independent claims, from which they depend, are in condition for allowance as set forth above. Accordingly, the dependent claims also are in condition for allowance. Applicant, however, reserves the right to address such rejections of the dependent claims in the future as appropriate.

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CONCLUSION

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance. An early and favorable examination on the merits is requested. In the event that a telephone conference would facilitate the examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

THE COMMISSIONER IS HEREBY AUTHORIZED TO CHARGE ANY ADDITIONAL FEES WHICH MAY BE REQUIRED FOR THE TIMELY CONSIDERATION OF THIS AMENDMENT UNDER 37 C.F.R. §§ 1.16 AND 1.17, OR CREDIT ANY OVERPAYMENT TO DEPOSIT ACCOUNT NO. 13-4500, ORDER NO. 1232-4723.

Respectfully submitted,
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Dated: March 16, 2005

By: _____


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